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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,914	04/12/2001	Michael R. Schrimp	6696.US.02	3833

23492 7590 10/16/2003

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 10/16/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No. 09/833,914	Applicant(s) SCHRIMPF et al.	
Examiner Brenda Coleman	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Sep 25, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see NOTE below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s):
see attached Advisory Action
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: 1, 2, 71-73, 80, and 81
- Claim(s) objected to: 28-32 and 34-40
- Claim(s) rejected: 27 and 33
- Claim(s) withdrawn from consideration: _____
8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Brenda Coleman
BRENDA COLEMAN
PRIMARY EXAMINER
ART UNIT 1624

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ADVISORY ACTION

The shortened statutory period for response expires THREE MONTHS from the date of the final rejection or as of the mailing date of this advisory action, whichever is later. In no event however, will the statutory period for response expire later than SIX MONTHS from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.

The amendment filed September 25, 2003 under 37 CFR 1.116 in response to the final rejection **has been** considered and **entered**, however the amendment is not sufficient to place the application in condition for allowance.

Claims 1, 2, 27-40, 71-73, 80 and 81 are pending in the application.

Response to Amendment

Applicant's amendment September 25, 2003 has been fully considered with the following effect:

1. The applicant's amendments are sufficient to overcome the improper Markush rejection or claims 1, 2, 71-73 and 76-79 labeled paragraph 1, maintained in the last office action, which is hereby **withdrawn**.

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2. The applicant's amendments are sufficient to overcome the 35 USC § 112, first paragraph rejection of claims 76-79 labeled paragraph 3, maintained in the last office action, which is hereby **withdrawn**.

3. The applicant's amendments are sufficient to overcome the 35 USC § 112, first paragraph new matter rejection of claims 1, 27, 28, 31, 34, 37, 40, 71-73 and 76-79 labeled paragraph 4 presented in the last office action, which is hereby **withdrawn**.

4. The applicant's amendments are sufficient to overcome the 35 USC § 112, second paragraph rejection of claim 71 labeled paragraph 5 presented in the last office action, which is hereby **withdrawn**.

In view of the amendment dated September 25, 2003, the following new grounds of rejection apply:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 27 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

a) Claim 27 is not further limiting of the claim from which it depends.

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- b) Claim 33 is vague and indefinite in that it is not known what is meant by octahydrpyrrolo in the nomenclature of the first species. It is believed that the applicant's intended octahydropyrrolo.

Claim Objections

6. Claims 28-32 and 34-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Allowable Subject Matter

7. Claims 1, 2, 71-73, 80 and 81 are allowed. None of the prior art of record nor a search in the pertinent art area teaches the compounds, compositions and method of use of the compounds of formula I or the species (cis)-3-(5,6-dichloro-3-pyridinyl)-3,6-diazabicyclo[3.2.0]heptane as claimed herein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays and Tuesdays from 9:00 AM to 3:00 PM and from 5:30 PM to 7:30 PM and on Wednesday thru Friday from 9:00 AM to 6:00 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink that reads "Brenda Coleman". The signature is fluid and cursive, with a large, sweeping loop at the end of the last name.

Brenda Coleman
Primary Examiner AU 1624
October 10, 2003